

REMARKS

Claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 remain pending. Each of these claims stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,999,912 ("Wodarz") in view of U.S. Patent No. 5,974,455 ("Monier"), U.S. Patent No. 6,108,637 ("Blumenau") and U.S. Patent No. 6,311,211 ("Shaw").

The pending rejections are identical to the rejections issued in the April 7, 2003 Office Action. In the interest of brevity, Applicants will not here repeat their response to those rejections, but instead incorporate by reference the response to those rejections set forth in Applicants June 4, 2003 *Response to the April 7, 2003 Office Action*. In light of this incorporation, in this response Applicants will only separately address the *Response to Arguments* set forth at pages 14-15 of the July 9, 2003 Office Action.

I. Blumenau Does Not Teach Storing A Record Of A User Request With The Unique Identifier Associated With The Content Object

The *Response to Arguments* section of the Office Action first addresses Applicants contention that the Blumenau reference fails to teach the claim recitation of "appending the stored record of the user request with the unique identifier associated with the content object." In the Office Action, the Examiner takes the position that since Blumenau indicates that a web page "can itself reference other files", Blumenau necessarily teaches storing the unique identifier associated with a content object in a log file. Applicants respectfully submit that Blumenau contains no such teaching.

Blumenau states that what is stored in the log file is "a record of [the] requests for files from the server computer." (Blumenau at Col. 2, lines 32-33). Blumenau states that these "requests" are user requests "to view a particular Web page" and that upon receipt of such a request "the server computer . . . transfers a file representing the Web page." (Blumenau at Col. 2, lines 12-13 and 20-22). While the Examiner is correct that Blumenau indicates that the file representing the requested web page may contain references to other files, this statement does not teach or suggest that unique

identifiers corresponding to content objects that constitute the web page are recorded in a log file for at least two independent reasons.

First, the Office Action assumes that the "references [to] other files" that may be contained in the file that is transferred in response to a request for a Web page constitute content objects that are used to generate the requested web page. Blumenau, however, provides no support whatsoever for this assumption. Thus, as Blumenau does not teach or disclose that additional files which comprise one or more "content objects" are transferred in response to a request for a Web page, Blumenau necessarily does not teach storing in a log file user requests that have appended to them the unique identifier associated with one or more content objects.

Second, Blumenau also does not teach that the log file contains a listing of each file that is transferred. To the contrary, what Blumenau expressly teaches is that the log file contains "a list of transactions that each represent a single file request." (Blumenau at Col. 2, lines 39-40, *see also* lines 42-43). As noted above, what the user requests is a particular Web page, and at the server computer a particular file that corresponds to this Web page resides. According to Blumenau, it is this requested file that is recorded in the log file. Blumenau does not teach that other files (such as files that may be referenced in the requested file) are also stored in the log file. This likewise shows that Blumenau does not teach or suggest storing the unique identifier associated with a content object in the log file. Thus, for each of these reasons Applicants respectfully submit that Blumenau does not teach what the Office Action states, and that the rejections of the pending claims should be withdrawn because none of the cited art teaches the step of "appending the stored record of the user request with the unique identifier associated with the content object."

II. The Office Action Fails To Identify Any Motivation In The Art For Combining The Monier And Wodarz References In The Manner Suggested

The *Response to Arguments* section of the Office Action next addresses Applicants contention that a person of skill in the art would not have been motivated

to modify the Wodarz reference to use the hash function discussed in Monier. With respect to this argument, the Office Action states that it "is obvious for a person of ordinary skill in the art to have looked for a way to generate unique identifier by using a hash function and modified it to combine into Wodarz in order to achieve Wodarz's objective of having unique identifiers to each advertisement." (Office Action at 15). Applicants respectfully submit that the Examiner's argument fails for at least two independent reasons.

First, as discussed in Applicants previous response, to support an obviousness rejection it must be shown that the prior art provided a motivation to combine the cited references to arrive at the claimed invention. Here, to the extent that the Office Action identifies any motivation to combine the Wodarz and Monier references, that motivation is not based on anything taught by the prior art, but instead is simply a conclusory statement that the skilled artisan would have found it obvious to do what is taught by the invention. Such evidence of motivation to combine is insufficient as a matter of law to support an obviousness rejection. *See In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Second, the Office Action does not even attempt to address Applicants argument that one of skill in the art would be motivated away from combining the Wodarz and Monier references in the manner suggested in the pending rejections. (*See June 4, 2003 Response to April 7, 2003 Office Action* at 17). As noted in Applicants' prior response, the Wodarz reference is directed to a method for rotating a small number of advertisements that are displayed on a web page. Thus, the "unique identifier" associated with each advertisement in Wodarz comprises a letter from the alphabet (specifically, the letters A-D are used to identify the four advertisements that are rotated into the web page). As Applicants discussed previously, there is absolutely no indication in Wodarz or Monier or any of the other cited references that the Wodarz invention would be further improved by using a hashing function to generate unique identifiers for these four advertisements. To the contrary, use of a hashing function clearly would not only be unnecessary; it also would be an inefficient use of resources and is exactly the type of modification to Wodarz that a

person of skill in the art would be motivated **not** to do. Applicants respectfully submit that it is only through hindsight based on the teachings of the present invention that the Examiner has combined the Wodarz and Monier references in the manner suggested in the pending rejections and, as such, those rejections should be withdrawn. Absent withdrawal of those rejections, Applicants respectfully request that the Examiner specifically identify the teachings in the prior art that the Examiner contends would have motivated the skilled artisan to combine the Wodarz and Monier references in the manner suggested, and that the Examiner further address Applicants argument that such a combination would be inefficient and unnecessary and precisely the type of combination that a person of skill in the art would not be motivated to make.

III. The Office Action Fails To Identify Any Motivation In The Art For Combining The Blumenau And Wodarz References In The Manner Suggested

Finally, the *Response to Arguments* section of the Office Action addresses Applicants contention that a person of skill in the art would not have been motivated to combine the Blumenau and Wodarz references in the manner suggested in the pending rejections. With respect to this issue, the Office Action further points to the Shaw reference as providing motivation to combine Wodarz and Blumenau since "Shaw further teaches processing web log to make use of the logged information in advertising." (Office Action at 15). The Shaw reference, however, simply does not provide the requisite motivation.

As explained at Col. 16, lines 12-31 of Shaw, the "event log file" and "advertisement statistics file" in Shaw keep track of statistics regarding the advertisements that the software selected to show to the user and software performance information. Shaw thus does not store and use information regarding the users selection of content objects for use in deciding what information to display to the user. In fact, Shaw, like Wodarz (*see* Wodarz at Col. 3, lines 65-67), teaches that the advertisements that are provided to the user are selected based on information stored in a member profile as opposed to information regarding the users web-page

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viewing choices. (See Shaw at Col. 4, lines 39-43). Shaw therefore fails to provide the motivation to combine the Wodarz and Blumenau references in the manner suggested. This provides an independent basis for withdrawal of the pending rejections.

CONCLUSION

Applicants submit that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 12, 2003.



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Date of Signature: August 12, 2003